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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/815,959

04/02/2004

Sonke Horn

41653-201083

7731

26694

7590

07/06/2007

VENABLE LLP

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EXAMINER

LAZORCIK, JASON L

ART UNIT

PAPER NUMBER

1731

MAIL DATE

DELIVERY MODE

07/06/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/815,959	<b>Applicant(s)</b> HORN ET AL.	
	<b>Examiner</b> Jason L. Lazorcik	<b>Art Unit</b> 1731	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-29 is/are rejected.
- 7) ☒ Claim(s) 28-29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/02/2004</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS filed 5/13/2005, 6/15/2005.</u>    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of claims 17-29 drawn to an apparatus for manufacturing filters in the reply filed on April 16, 2007 is acknowledged.

### ***Claim Objections***

Claims 28 and 29 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It is unclear how a limitation drawn to the average fiber diameter for use in the claimed fiber apparatus further limits the structure of the claimed filter manufacturing apparatus. Since it appears that these claims are drawn to an intended use of the apparatus and not explicitly to a structural feature of said apparatus, the identified claims are objected to for a failure to further limit the parent claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites the limitation "The mass of fiber material" in 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "the filter material" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 22 recites the limitation "the lower region of the metering device" in line 2. There is insufficient antecedent basis for this limitation in the claim.

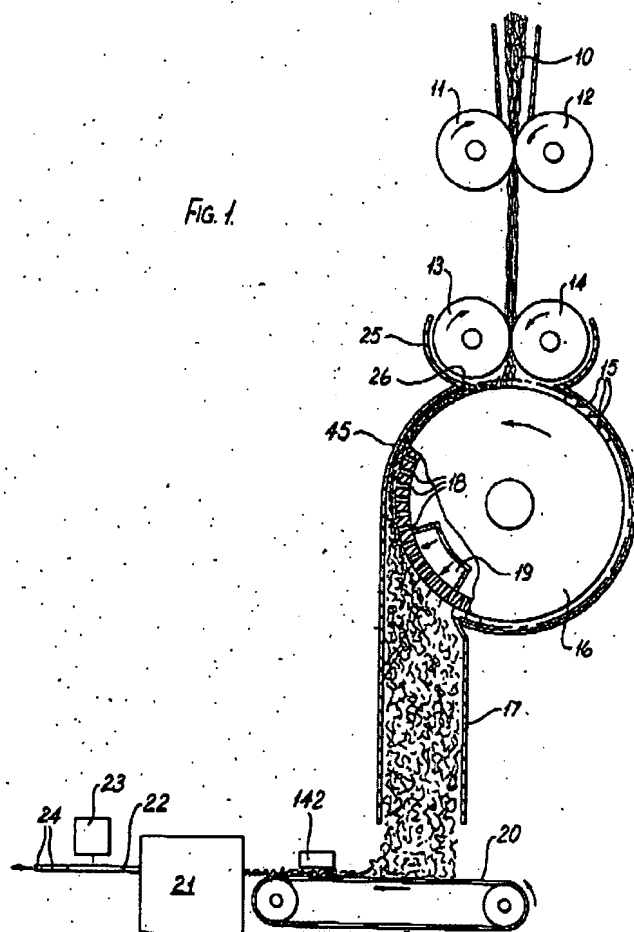
### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Preston (US 4,593,706).

With particular reference to the following excerpt Figure 1 below, Preston teaches an apparatus for processing a mass of filter material (10) comprised of finite fibers for manufacture into a filter element. The apparatus disclosed in the Preston reference comprises a metering device (11, 12), a separating device (16, 45), and a means for feeding the filter material from the metering device to the separating device (13, 14, 25).

The metering device comprises a drop chute (depicted flanking the tow (10)) and a pair of rotating rollers (11, 12) located in the lower region of said drop chute for removing the fibers therefrom (**Claim 21,22**). The reference teaches these rotating rollers (11,12) act as the claimed "fiber separating element" (**Claim 24**) by cooperating with the rollers 13 and 14 to "stretch the tow" (Column 3, lines 35-43).



With respect to the separating device, Preston teaches the claimed rotating element (16), the periphery of which is “formed with approximately radial passages (18) through which air is blown outward” (Claims 18, 19, 23).

Regarding the claimed mixing device, Preston teaches that “there may be means for applying a plasticizer, e.g. in any known manner; alternatively, plasticizer may be blown out through the passages (18) or otherwise applied after the tow has reached the roller (16) and at least partially broken”. Where application of the plasticizer is viewed as a positive step of mixing the fibers and other additives together, the separating device (16, 45) is understood to serve a dual role as the claimed “mixing device”

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(**Claims 25, 26**). Under an alternate embodiment, Preston teaches that the plasticizer "could be applied by the guiding means, i.e. before the filaments are broken". Under this latter embodiment, the mixing device is understood to comprise the guiding members of the fiber metering device (**Claim 27**).

Claims 28-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Preston (US 4,593,706).

As indicated above, the claim directed to the preferred fiber diameter intended to be processed by the instant apparatus was objected as failing to further limit the structure of said apparatus. With this point in mind, the instant claims are further understood to be either anticipated by Preston or alternatively rendered obvious in light of these teachings. Preston indicates that the preferred use for the disclosed apparatus is for the processing of cellulose acetate fibers for cigarette filters. Although the reference does not explicitly limit the average fiber diameter, said limitation is understood to be either an implicit teaching of the Preston reference or alternatively rendered as a readily evident alternative to said teachings for one of ordinary skill in the art.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L. Lazorcik whose telephone number is (571) 272-2217. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLL

  
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